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In re Application of
TRIFONI, et al.
Serial No.: 10/550,123
PCT No.: PCT/EP04/03424
Int. Filing Date: 31 March 2004
Priority Date: 01 April 2003
Atty Docket No.: 267.193
For: METHOD FOR OPERATING A
MEMBRANE ELECTROCHEMICAL
GENERATOR

: DECISION ON PETITION
: UNDER 37 CFR 1.47(a)

This decision is in response to applicant's "RENEWED RULE 47(a) PETITION" filed 07 September 2006 to accept the application without the signatures of joint inventors, Eduardo Trifoni and Matteo Lenardon.

BACKGROUND

On 22 March 2006, applicant filed a petition under 37 CFR 1.47(a) to accept the application without the signatures of joint inventors Eduardo Trifoni and Matteo Lenardon.

On 04 August 2006, a decision on petition was mailed to applicant indicating that all of the requirements of 37 CFR 1.47(a) were not satisfied. On 07 September 2006, a renewed petition was filed.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(g), (2) factual proof that the missing joint investor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

Regarding item (1), applicant has now provided the petition fee. Item (1) is satisfied. With regard to Item (3), the last known addresses of the nonsigning inventors were provided. The declarations executed by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor were previously provided and thus, Item (4) above was satisfied.

However, regarding item (2) above, Petitioner states that Eduardo Trifoni and Matteo Lenardon have refused to sign the application. Section 409.03(d) of the MPEP, Proof of Unavailability or Refusal, states, in part:

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Proof that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts. The document may be redacted to remove material not related to the inventor's reasons for refusal.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition. **If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.**

(Emphasis added).

In her August 28, 2006 declaration, submitted with the renewed petition, Annie Tuosto states that "the documents she submitted to the two inventors who refused to execute the above application included a complete application, drawings, claims, declaration and assignment for execution and identified the application by PCT serial no.: PCT/EP04/03424".

Ms. Tuosto states that she mailed a complete copy of the application, including claims, drawings, declaration and assignment document to Mr. Lenardon. However, a copy of the cover letter (and English translation) was not provided and should be produced as documentary

evidence that these documents were mailed to the nonsigning inventor. The letter must identify the application number and identify the enclosures that were sent to Mr. Lenardon. The cover letter of 21 December 2005 does not identify the application to which it was directed and does not itemize the documents that were enclosed.

Moreover, the postal receipt (a copy of which was submitted on 22 March 2006) was not translated from the Italian language into the English language. Thus, it is unclear that Mr. Lenardon actually received these application papers. Mr. Lenardon's silence cannot be construed as a refusal under the immediate circumstances until it is clear that he received a complete copy of the application papers, including description, claims, drawings and declaration for his execution and refuses to sign them.

As to inventor Trifoni, Ms. Tuosto states that Mr. Trifoni was contacted via email. However, no documentary proof of delivery of these application papers via email or postal service was provided. That is, a copy of the email (and English translation thereof) to Mr. Trifoni indicating that a complete copy of this application, including claims, drawings, and declaration were delivered to the nonsigning inventor. A copy of Ms. Tuosto's email should accompany the renewed petition. Mr. Trifoni's reply to the email (and English translation thereof) should also be provided to demonstrate the non-signing inventor's refusal to sign the application papers. In cases where it is argued that the non-action of an inventor should be considered a refusal to cooperate it is especially important to provide proof of delivery of the papers, as well as, a firsthand statement of the preparation and mailing of the papers.

As stated above, where a refusal of the inventor to sign the application papers is alleged, a statement of facts is needed from a person having first hand knowledge of the facts that a complete copy of the papers for this application (specification, claims, drawings and oath/declaration) were sent to Eduardo Trifoni and Matteo Lenardon, and when such papers were sent. In addition, copies of documentary evidence such as a certified mail return receipt, cover letter of instruction, telegrams, etc., should be supplied with the declaration. All documentary evidence should be translated into English. See MPEP 409.03(d) for further clarification.

Applicant has not presented sufficient evidence to show that Messrs. Lenardon and Trifoni were presented with and received a complete copy of the application papers including a declaration and that they refuse to sign the application papers. In light of the above, Item (2) above is not yet satisfied and thus, it is inappropriate to grant applicant's petition under 37 CFR 1.47(a) at this time.

CONCLUSION

For the reasons stated above, applicant's petition under 37 CFR 1.47(a) is **DISMISSED**.

Any reconsideration on the merits of this petition must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be directed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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